

Applicants: Reba Goodman, et al.
U.S. Serial No.: 09/769,902
Filed: January 25, 2001
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Remarks

Claims 1, 8, 13, 22, and 30 are pending in the subject application. By this Amendment, applicants have amended claims 1 and 22. Applicants maintain that amended claim 1 raises no issue of new matter and is fully supported by the specification as filed. Support for amended claim 1 may be found inter alia in the specification, as originally filed, on page 4, lines 5-12; page 16, lines 20-24; and at page 6, lines 15 and 19. Support for amended claim 22 may be found inter alia in the specification, as originally filed, on page 4, lines 13-21; page 8, line 23 through page 9 line 30; page 15, line 16 through page 16, line 5; page 16, lines 20-24; and page 6, lines 15-19. Accordingly, applicants respectfully request entry of this Amendment. Upon entry of this Amendment, claims 1-30 will be pending and under examination.

Claims Rejected under 35 U.S.C. §112 (Enablement)

The Examiner stated that claims 1, 8, 22, and 30 remain rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking enablement for the full scope of the claimed subject matter. The Examiner alleged that the broadest reasonable interpretation of the claims encompasses a method of regulating expression *in vitro* or *in vivo*, and that the claims lack enablement for the method practiced *in vivo*.

In response, applicants respectfully traverse the Examiner's rejection. However, in order to expedite prosecution, but without conceding the correctness of the Examiner's position, applicants have hereinabove amended claim 1 to recite the term "*in vitro*". Accordingly, applicants maintain that the method as claimed is fully enabled by the specification as filed, and

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respectfully request that the Examiner reconsider and withdraw this ground of rejection.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

 12/7/04

Peter J. Phillips Date
Registration No. 29,691